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**Datasheet for the decision
of 23 February 2018**

Case Number: T 1304/14 - 3.3.04

Application Number: 07856324.4

Publication Number: 2120982

IPC: A61K38/00, C07K7/00

Language of the proceedings: EN

Title of invention:

Polypeptides having modulatory effects on cells

Applicant:

Rudkin, Brian

Headword:

Aptamer/RUDKIN

Relevant legal provisions:

EPC Art. 113(2)

RPBA Art. 12(4)

Keyword:

Main request - could have been filed in first instance
proceedings (yes), admitted (no)

Basis of decision - text submitted or agreed by applicant (no)

Decisions cited:

Catchword:



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Case Number: T 1304/14 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 23 February 2018

Appellant: Rudkin, Brian
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Representative: Almond-Martin, Carol
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 20 December 2013 refusing European patent application No. 07856324.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman G. Alt
Members: R. Morawetz
M. Blasi

Summary of Facts and Submissions

- I. The appeal lies against the decision of the examining division refusing European patent application No. 07 856 324.4 entitled "*Polypeptides having modulatory effects on cells*". The application had been filed as international application PCT/EP2007/010422 and published as WO 2008/064907.

- II. In the first-instance proceedings, the examining division had issued a communication pursuant to Article 94(3) EPC raising several objections, in particular lack of inventive step in relation to the claim request pending before it. The joint applicants replaced the claim request with a new set of claims in which, *inter alia*, features from former claims 2 and 3 had been included in claim 1. The examining division then summoned them to oral proceedings and explained in an accompanying communication why the claims of the sole request before it did not comply with the requirements of Articles 54, 56, 82, 83 and 84 EPC. Subsequently, the joint applicants withdrew their request for oral proceedings and agreed to the issue of a decision according to the state of the file.

- III. With their statement of grounds of appeal, the joint applicants ("former appellants", see also section IV) submitted a new, single set of claims comprising 28 claims which replaced "*all requests previously on file*". The former appellants also addressed all issues in the decision under appeal submitting, *inter alia*, arguments why, on the basis of this set of claims, the requirements of Articles 54, 56, 82, 83 and 84 EPC were met.

Claim 1 of the single claim request reads:

"1. A peptide ~~comprising or~~ consisting of
(i) the amino acid sequence SAVTFAVCAL (SEQ ID 20), or
(ii) the amino acid sequence GPSAVTFAVCALGP
(SEQ ID 21), or
(iii) a variant of the amino acid sequence (i) or (ii)
having one amino acid change,
said polypeptide being capable of ~~binding to a protein~~
~~which comprises at least the sequence extending from~~
~~amino acid 378 to 500 of the beta isoform of~~
~~calcineurin A, to Calcineurin A and/or to NS5A-TP2, and~~
~~having a modulatory effect on a eukaryotic cell wherein~~
~~said polypeptide has an antiproliferative effect on~~
~~said cell~~ **giving rise to a specific detectable**
phenotype or phenotype change, wherein the specific
detectable phenotype or phenotype change is brought
about by the binding of said peptide to an
intracellular target within a mammalian cell, and
wherein said specific detectable phenotype or phenotype
change is an antiproliferative effect or a
differentiating effect on mammalian cells, or is a
reduction of muscular atrophy" (deletions with respect
to claim 1 underlying the decision under appeal are
marked by strikethrough and additions are marked in
bold).

IV. In the course of the appeal proceedings, a transfer of the patent application to the appellant was registered. The appellant was summoned to oral proceedings and informed of the board's preliminary opinion in a communication pursuant to Article 15(1) RPBA.

In points 6 to 12 of this communication the board observed that it considered the admissibility of the single claim request to be an issue.

Moreover the board indicated that claim 1 appeared to fail the requirements of Article 84 EPC (see points 20 to 27), that the subject-matter of claims 1, 4, 5, 6, 13, 15, 25 and 28 appeared to extend beyond the content of the application as filed (see points 29 to 38), that claim 25 was considered to lack clarity (see point 39) and that the provision of any aptamer, besides R5G42, was considered to involve an undue burden for the skilled person contrary to Article 83 EPC (see point 40).

- V. The board was informed that nobody would attend the oral proceedings on behalf of the appellant. The request for oral proceedings was withdrawn. A substantive reply was not filed.
- VI. Oral proceedings before the board took place on 23 February 2018, in the absence of the appellant. At the end of the oral proceedings the chairwoman announced the board's decision.
- VII. The appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims in the main request, filed as a sole request together with the statement of grounds of appeal.

Reasons for the Decision

- 1. Although the appellant had withdrawn its request for oral proceedings the board considered it expedient that the oral proceedings take place as scheduled in accordance with Article 116(1) EPC. The duly summoned appellant was neither present nor represented at the oral proceedings. The board decided to continue the

proceedings without the appellant in accordance with Rule 115(2) EPC and treated him as relying on his written case in accordance with Article 15(3) RPBA.

Admission of the sole set of claims (Article 12(4) RPBA)

2. The set of claims in the request now at issue was submitted with the statement of grounds of appeal.

It differs from the set of claims in the sole request underlying the decision under appeal in amendments to claims 1, 7 to 10, 12 to 14, 17 to 19 and 22 to 28, the insertion of new claims 2 to 6, 11, 15, 16, 20 and 21, and the deletion of previous claims 2, 3, 16, 17, 22 to 24 and 26.

No such a set of claims had been submitted in the proceedings before the examining division.

3. Article 12(4) RPBA provides that, without prejudice to the power of the board to hold inadmissible facts, evidence or requests which could have been presented in the first-instance proceedings, everything presented by the parties pursuant to Article 12(1) RPBA, i.e. in *ex parte* proceedings the notice of appeal and the statement of grounds of appeal in particular, has to be taken into account by the board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA.

The board, in line with the established case law (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.4.3.3b)), therefore concludes that it has discretion over whether or not to hold inadmissible claim requests which, although they could have been, were not presented by an applicant in the

proceedings before the examining division.

The board considers that whether the claim request at issue "*could have been presented in the first instance proceedings*" within the meaning of Article 12(4) RPBA depends on whether or not the applicant could have been expected to present it to the examining division in the circumstances of the specific case.

4. In the board's opinion, the former appellants could indeed have been expected to present the set of claims filed with the statement of grounds of appeal in the proceedings before the examining division for the following reasons.

The former appellants had a first opportunity to file observations or amendments in reply to the examining division's communication under Article 94(3) EPC which they used by replacing the then pending claim request with a new claim set in which, *inter alia*, further features had been added to claim 1. When summoning them to oral proceedings, the examining division had given, in the annex to the summons, reasons why it considered that the single set of claims then on file failed to meet the requirements of Articles 54, 56, 82, 83 and 84 EPC. The former appellants neither commented on the substance of the communication nor submitted amended claims and so made no further effort to obtain a favourable decision. Instead, they withdrew their request for oral proceedings, announced their absence from the oral proceedings and agreed to the issue of a decision according to the state of the file.

5. The reasons for the refusal in the decision under appeal were then the same as those in the annex to the summons to the oral proceedings. When filing the

statement of grounds of appeal the former appellants were therefore in the same situation as regards the substantive objections as when they had been summoned for oral proceedings by the examining division. In the board's view it is thus apparent that the former appellants could indeed have filed the amended set of claims which was filed with the statement of grounds of appeal when responding to the examining division's summons to oral proceedings at the latest.

6. The board has seen no explanation either in the notice of appeal or the statement of grounds of appeal as to why this amended claim request had not been submitted to the examining division even though it could have been submitted at the latest in response to the examining division's summons to oral proceedings.
7. The newly registered appellant, having received the board's communication in which the board had indicated that it considered the admissibility of the claim request to be an issue, likewise made no submissions in this respect. In this context, the board further notes that the appellant must accept the consequences of the procedural history of the case, even where they are to his detriment.
8. In addition, in the board's opinion, the set of claims presented with the statement of grounds of appeal is also not clearly allowable because it gives rise to further objections, as was set out in the board's communication to the appellant in preparation for the oral proceedings (see also points 20 to 40 of the board's communication). The appellant has not submitted any arguments aimed at dissuading the board in this respect and, hence, the board has not been given any reason to deviate from this opinion.

9. In view of the above considerations, the board decided in accordance with Article 12(4) RPBA not to admit the set of claims filed with the statement of grounds of appeal into the appeal proceedings.
10. Therefore, the appellant's request that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims in the main request, filed as sole request together with the statement of grounds of appeal, is refused.
11. As the appellant had replaced all previous requests with the main request filed together with the statement of grounds of appeal, there is, in view of the non-admission of the main request by the board, no further text approved by the appellant within the meaning of Article 113(2) EPC in the appeal proceedings on the basis of which a patent could be granted. Accordingly, the decision under appeal refusing the patent application cannot be set aside and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated